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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/170,656	10/14/1998	SURESH JEYACHANDRAN	35.C13009	7028
5514	7590	12/14/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			LEE, TOMMY D	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/170,656

Applicant(s)

JEYACHANDRAN ET AL.

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23, 24, 27-30, 32, 33 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 23, 24, 27-30, 32, 33 and 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 18, 2004 has been entered.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-21, 23, 24, 27-30, 32, 33 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,291,302 (Gordon et al.) in view of U.S. Patent 6,043,904 (Nickerson).

Regarding apparatus claims 1, 4 and 5; and corresponding method claims 10, 13 and 14, Gordon et al. disclose an information processing apparatus comprising identification name designation means for designating by a user (subscriber places call to destination via SAFF system, read column 8, lines 4-16; originator and destination telephone numbers transmitted to destination SAFF in response to call, read column 8, lines 36-44) an identification name (including at least one of an information name, an information transmitter name, and an information sender name) related to object information (originating machine's identification, destination machine's telephone

number stored, read column 7, lines 4-13); process designation means for designating by the user (user prompted to select desired choices by pressing particular numbers on keypad, read column 9, lines 47-63) a process (including at least one of reception, of transmission, and of printing) for said object information (fax message delivered to destination machine, read column 7, lines 15-20); and determination means for determining whether or not a performed process matches the designated process (upon successful delivery, "delivery record" created and sent back to the originating machine as a fax message, read column 9, lines 1-15).

Gordon et al. do not disclose setup means for setting up by the user in advance of performing the process, as an execution condition for a command to be executed, the process designated by said process designation means and the identification name designated by said identification name designation means; or execution means for executing the command for which the execution condition is set up by said setup means when said determination means determines that the performed process matches the designated process and that the identification name related to the object information of the performed process matches the designated identification name. Nickerson discloses a method for communicating job status information, wherein prior to transmission of a document a user inputs information regarding delivery of job confirmation information to a remote location (column 9, line 45 – column 10, line 7). Upon execution of transmission of the document, it is determined whether remote confirmation is required, and the remote confirmation is performed according to the determination (column 9, lines 1-33; column 10, lines 35-62). The confirmation is

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transmitted to an E-mail address relating to a confirmation destination previously determined (column 10, lines 51-60). Nickerson recognized that it is sometimes desirable to transmit a confirmation report to a location remote from the location where a document is transmitted, in the case where the document's originator is off-site relative to the transmission job originating station (column 2, lines 15-28). Gordon et al. do not disclose a capability for transmitting confirmation reports to locations remote from the originating source, and thus it would have been obvious for one of ordinary skill in the art to modify the teaching of Gordon et al. by providing a feature allowing for transmission of confirmation reports to remote locations, as disclosed by Nickerson.

Regarding apparatus claims 2 and 9; and corresponding method claims 11 and 18, the facsimile apparatus disclosed in Nickerson does not appear to provide, in combination, time limit setup means for setting a time limit; and inhibition means for inhibiting said execution means from executing the command when the time limit set by said time limit setup means has expired; or management means for deleting the command set by said setup means when the time limit sat by said time limit setup means has expired (Gordon et al. do not disclose setup means or execution means as recited in the claims, and thus do not disclose inhibition means for inhibiting said execution means or management means for deleting a command from setup means). However, it is well known in the art to provide a time limit for entering a command for performing a process, and for inhibiting or deleting the process when that time limit is reached, so that a user need not input a specific command if he or she decides to abort the process. It would have been obvious to one of ordinary skill in the art that such a

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limitation would be advantageous for operation of the facsimile apparatus disclosed by Nickerson, for if no time limit were set for entering remote location information in the process described in Nickerson (column 9, line 61 – column 10, line 20), then the facsimile apparatus would not be able to conclude the current transmission job if a user changes his or her mind and decides not to have a confirmation report transmitted to a remote location, without entering a specific command. Therefore, it would have been obvious for one of ordinary skill in the art to provide a time-out feature and management of a setup process responsive to the time-out feature, in the combined teaching of Gordon et al. and Nickerson.

Regarding apparatus claim 3 and corresponding method claim 12, Gordon et al. further comprises status designation means for designating a status of said apparatus; and permission means for permitting said execution means to execute the command when the status designated by said status designation means is established (when the status of the apparatus allows for successful reception of fax message, a delivery record is created, as mentioned above).

Regarding apparatus claims 6-8 and corresponding method claims 15-17, Nickerson further provides a command for issuing a notification that said designation process has been completed (confirmation sheet issued (column 9, lines 8-33)), and a command for performing a further process related to the object information, including at least one of printing or of holding of the object information (job is either developed at the printing system or transmitted to the printing system (column 11, lines 21-25)).

As for a storage medium which stores a program for performing the method steps as recited in claim 19, Gordon et al. provide software control as disclosed at column 19, beginning from line 22. It would have been obvious to providing the setup and execution steps of Nickerson (see above rejection of claims 1 and 10) in the program disclosed in Gordon et al., so that a confirmation report may be sent to a remote location according to setup procedures provided in Nickerson.

Apparatus claims 20, 21, 23, 27; and corresponding method claims 29, 30, 32 and 36, are similar to respective apparatus claims 1, 2, 5, 8; and method claims 10, 11, 14 and 17, but more broadly recite processes for object information and a command to be executed as first and second processes, respectively. In the cited prior art, the first and second processes read on Gordon et al.'s fax message delivery and Nickerson's information regarding delivery of job confirmation information to a remote location, as set forth above. Therefore, claims 20, 21, 23, 27, 29, 30, 32 and 36 are rejected for the reasons set forth above with respect to claims 1, 2, 5, 8, 10, 11, 14 and 17.

Regarding apparatus claim 24 and corresponding method claim 33, Gordon et al. further disclose a designation of at least one of a user name, an apparatus, and a process name as an attribute for the specific process (originating machine's identification, destination machine's telephone number stored, read column 7, lines 4-13).

Regarding apparatus claim 28 and corresponding method claim 37, Gordon et al. further disclose a capability of executing at least one of reading and printing of

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information (reports accumulated and delivered as fax document, read column 10, lines 18-35).

As for a storage medium which stores a program for performing the method steps as recited in claim 38, Gordon et al. provide software control as disclosed at column 19, beginning from line 22. It would have been obvious to providing the setup and execution steps of Nickerson (see above rejection of claims 1, 10, 20 and 29) in the program disclosed in Gordon et al., so that a confirmation report may be sent to a remote location according to setup procedures provided in Nickerson.

Response to Arguments

4. Applicant's arguments filed in response to prior rejection of the above claims as set forth in the Office action mailed June 10, 2004 have been fully considered but they are not persuasive.

Applicant asserts, on page 16, lines 3-17, of the response filed October 18, 2004, that there is nothing in Nickerson in which the performance of one process, in particular, the performance of a job notification process, invokes the execution of a second process. Contrary to applicant's assertion, Nickerson discloses execution of a second process invoked by the performance of a first process. As mentioned above, Nickerson discloses that upon execution of transmission of the document, it is determined whether remote confirmation is required, and the remote confirmation is performed according to the determination (column 9, lines 1-33; column 10, lines 35-62). The transmission of the document is the first process that invokes the second process of remote confirmation according to the determination.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
December 7, 2004